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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SHO-0043	
	Application Number 10/697,027-Conf. #1099	Filed October 31, 2003	
	First Named Inventor Kazuo OKADA		
	Art Unit 3714	Examiner R. Hsu	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,211</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p> Signature Carl Schaukowitch Typed or printed name</p> <p><u>(202) 955-3750</u> Telephone number <u>March 5, 2008</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> form is submitted.</p>			



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kazuo OKADA

Application No.: 10/697,027

Filed: October 31, 2003

For: GAMING MACHINE

Attorney Docket No.: SHO-0047

Examiner: R. Hsu

Art Unit: 3714

Confirmation No.: 1099

ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The Examiner issued an Advisory Action dated April 4, 2007, in response to Applicant's Request for Reconsideration under 37 CFR 1.112 filed on March 7, 2007. Applicants' Request for Reconsideration was filed in response to the final Office Action dated November 1, 2006. A complete listing of the claims and the appropriate status identifiers can be found in Applicant's Request for Reconsideration on pages 2-4. No amendments were made to the claims in Applicants' Request for Reconsideration.

The period for response is extended to May 1, 2007, by the Petition for Extension of Time filed herewith.

Claims 1-10 are rejected under 35 USC 103 (a) as being unpatentable over Motegi et al. (U.S. Patent No. 6,817,946) in view of Basturk et al. (U.S. Patent No. 6,600,527). The rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness

is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) quoting In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1776). The mere fact that the prior art *may* be modified in the manner suggested by the Examiner neither makes the modification *prima facie* obvious or obvious unless the prior art suggested the desirability of the modification. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the references to arrive at the claimed invention. If the Examiner fails to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned.

Examiners must make appropriate rejections regarding the obviousness of claimed inventions in light of the recent Supreme Court's decision in KSR International Co. v. Teleflex Inc., 550 U.S. __, 82 USPQ2d 1385 (2007). The familiar factual inquiries announced by the Supreme Court in its much earlier decision, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), remain the basis for every decision regarding obviousness, i.e., Examiners will continue to consider:

- (1) the scope and content of the prior art,
- (2) the differences between the claimed invention and the prior art,
- (3) the level of ordinary skill in the pertinent art, and
- (4) objective evidence relevant to the issue of obviousness.

In the gaming machine of present invention, the LCD panel, the diffusion sheet, the light guiding plate and the variable display device are arranged in this order from a player side as it is described claim 1. The gaming machine of present invention is composed so as to be seen the variable display device via the LCD panel. Besides, the LCD panel, the diffusion sheet and the light guiding plate are arranged facially-opposed sequential manner.

On the other hand, in the gaming machine of Motegi, the protection glass 1g, the half mirror 1m and the LCD panel 5 are arranged in this order from a player side as it is described Fig 5. Reels 6a, 6b, 6c are arranged on upper side of the half mirror 1m. By this, an image is displayed on the LCD panel 5 and an image of the reels 6a, 6b, 6c are reflected by the half mirror 1m, both images are overlapped. In other words, in the gaming machine of Motegi, the LCD panel 5 is situated on rear side of the half mirror 1m and rear side of the reels 6a, 6b, 6c in the obliquely downward direction. By doing it in this way, overlapping of both images is able to be realized. Therefore, an arrangement of the LCD 5 panel on front side of the reels 6a, 6b, 6c is impossible. Besides, the protection glass 1g, the half mirror 1m and the LCD panel 5 can not be arranged in facially-opposed sequential manner judging from a function of the half minor 1m.

Besides, the United States Patent and Trademark Office states that the arrangement of the LCD panel, the diffusion sheet and the light guiding plate of present invention is disclosed in Basturk. However, it is not clear which constitution of Basturk corresponds to the LCD panel, the diffusion sheet and the light guiding plate of present invention. It is respectfully submitted that the Applicants are perplexed by the position of the United States Patent and Trademark Office.

In Motegi, since the LCD panel 5 is situated on rear side of reels 6a, 6b, 6c in the obliquely downward direction, even if Basturk is combined to Motegi, the present invention can not to be realized.

It is respectfully submitted that none of the applied art, alone or in combination, teaches or suggest the features of the claims as discussed above. Thus, one of ordinary skill in the art would not be motivated to combine the features of the applied art because such combination would not result in the claimed invention. As a result, it is respectfully submitted that the pending claims are allowable over the applied art.

Withdrawal of the rejection is respectfully requested.

Claims 1-10 are provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 3-7 of copending Application No. 10/697,238. A Terminal Disclaimer was filed with the Request for Reconsideration filed March 7, 2007, to obviate the rejection.

Withdrawal of the rejection is respectfully requested.

Based upon the above, it is respectfully submitted that the Examiner cannot support the *Graham* factual inquiries as required under KSR nor has the Examiner established a *prima facie* case of obviousness under the Teaching, Suggestion, Motivation Test.

Further, Applicants assert that there are also reasons other than those set forth above why the pending claims are patentable. Applicants hereby reserve the right to submit those other reasons and to argue for the patentability of claims not explicitly addressed herein in future papers.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

By:


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Date: March 5, 2008

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Enclosure(s): Notice of Appeal
 Pre-Appeal Brief Request for Review
 Petition for Extension of Time (three months - two months)

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